



Docket No. 5000-5147

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Kazuya KIMURA, et al.

Group Art Unit: 3746

Serial No.: 10/781,218

Examiner: TBA

Filed: February 17, 2004

For: ELECTRIC COMPRESSOR AND METHOD OF ASSEMBLING THE SAME

**IDENTIFICATION OF LESS THAN TEN ATTORNEYS TO BE MADE OF  
RECORD FROM LISTING IN ORIGINALLY FILED  
POWER OF ATTORNEY**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants seek to designate the below identified registered patent attorneys to be made of record for the above-identified application.

On May 27, 2004, Applicants filed a fully executed combined Declaration And Power Of Attorney form that lists more than ten registered patent attorneys to whom power of attorney was granted. Pursuant to new 37 C.F.R. §1.32(c), the Filing Receipt dated December 14, 2004 stated: "Power of Attorney: Steven F. Meyer--35613".

These very same circumstances were addressed in the Federal Register notice for new §1.32.

If more than ten patent practitioners are listed on a power of attorney, and no separate paper under §1.32(c)(3) is filed, then no patent practitioners will be made of record... Applicant may then submit a newly executed power of attorney complying with §1.32, or submit a copy of the previously filed power of attorney

accompanied by a separate paper indicating which ten practitioners are to be made of record pursuant to §1.32(c)(3).

69 Fed Reg. 29865, 29867 (May 26, 2004) [attached at Exh. A]. A copy of the previously filed power of attorney is attached as Exh. B.

This filing constitutes the “separate paper indicating which ten [or less] practitioners are to be made of record pursuant to §1.32(c)(3).” Applicants designate the following registered patent attorneys from the previously filed power of attorney to be made of record for the subject application:

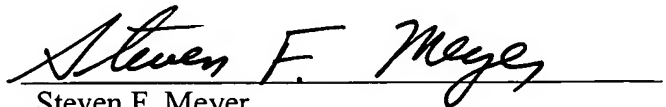
1. Steven F. Meyer (Reg. No. 35,613)
2. Arnold I. Rady (Reg. No. 26,601)
3. Joseph A. Calvaruso (Reg. No. 28,287)

By separate paper filed concurrently herewith, Applicants seek to correct the Filing Receipt to identify the above-listed registered patent attorneys as having power of attorney for the above-identified application.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: December 22, 2004

By:



Steven F. Meyer  
Registration No. 35,613

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to-navigation position. Navigation at the site of the bridge consists mainly of tows with barges and some recreational pleasure craft. Due to prior experience, as well as coordination with waterway users, it has been determined that this closure will not have a significant effect on these vessels. No alternate routes are available. The bridge will be able to open for emergencies.

In accordance with 33 CFR 117.35(c), this work will be performed with all due speed in order to return the bridge to normal operation as soon as possible. This deviation from the operating regulations is authorized under 33 CFR 117.35.

Dated: May 13, 2004.

Marcus Redford,

Bridge Administrator.

[FR Doc. 04-11893 Filed 5-25-04; 8:45 am]

BILLING CODE 4910-15-P

## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

#### 37 CFR Parts 1, 3 and 5

[Docket No.: 2003-P-019]

RIN 0651-AB63

#### Revision of Power of Attorney and Assignment Practice

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is revising the rules of practice to allow for more efficient processing of powers of attorney and assignment documents within the Office. For example, the Office will require applicants to use the Office's Customer Number practice if more than ten registered patent practitioners are to be made of record. In addition, the Office is eliminating some mail stops (*i.e.*, CPA, Provisional Patent Application) that were found not be useful in routing correspondence within the Office, and creating a new mail stop (Licensing and Review) to assist the Office in the proper routing of national security classified and secrecy order papers. Finally, because the Office is discontinuing the current Office practice of returning patent and trademark assignment documents submitted by mail for recording in the assignment database, only copies of assignment documents may be submitted for recording in the Office's Assignment records.

**DATES:** *Effective Date:* June 25, 2004.

Any associate power of attorney filed

before this date will continue to be effective.

#### FOR FURTHER INFORMATION CONTACT:

Karin Ferriter ((703) 306-3159) (Office of the Deputy Commissioner for Patent Examination Policy), Mary Hannon ((703) 308-8910, ext. 137) (Office of the Commissioner for Trademarks), or Robert J. Spar ((703) 308-5107) (Office of the Deputy Commissioner for Patent Examination Policy), directly by phone, or by facsimile to (703) 872-9411, or by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**SUPPLEMENTARY INFORMATION:** A purpose of this final rule is to limit the number of patent practitioners that a patent applicant, or an assignee of the patent applicant, can name in a power of attorney. If more than ten registered patent attorneys or registered patent agents are to be appointed, then the Office's Customer Number practice must be used. This change is necessary to eliminate the undue processing burden on the Office when a power of attorney naming more than ten patent practitioners is submitted in patent applications. In addition, a purpose of this final rule is to eliminate the associate power of attorney practice in patent cases. An associate power of attorney is not necessary for a patent practitioner to take most actions in a patent application. Instead of filing an associate power of attorney, a patent practitioner can file an "Authorization to Act in a Representative Capacity" (note the sample form posted on the Office's Internet Web site at: <http://www.uspto.gov/web/forms/sb0084.pdf>). Another purpose of this final rule is to eliminate an original assignment document from the list of documents that may be submitted for recordation. This is because the Office shall no longer be returning assignment documents after they have been scanned into the Office's electronic assignment database, and any assignee that submits the original assignment document will be unable to retrieve the document.

The Office provides for the use of a Customer Number to identify either an address for patent-related correspondence, or a set of patent attorneys and agents who may be identified with a patent application as patent practitioners of record. Customer Number practice permits the correspondence or fee address, or the list of practitioners of record to be easily changed in a large number of patent applications by filing a single request for Customer Number data change. A separate revocation of power of

attorney, or appointment of a new power of attorney would not need to be filed in each patent application if a Customer Number Data Change Request (PTO/SB/124) is filed. As a result, if a patent attorney or patent agent is to begin to represent a client, or is discontinuing representation of a client, on a particular set of applications, and, if the power of attorney for that set of applications was originally to the patent practitioners associated with a Customer Number, then the list of patent practitioners associated with the Customer Number should be changed to reflect the addition or deletion. When Customer Number practice is used, a separate document does not need to be filed by applicant for each application in which the list of practitioners associated with the Customer Number is to be changed; only one Customer Number Data Change Request is required to eliminate any patent practitioners who should no longer be associated with the Customer Number. Alternatively, a new power of attorney to a list of patent practitioners or to the patent practitioners associated with a different customer number may be filed in each application in which the power of attorney should be changed.

The rules pertaining to power of attorney are revised to reflect Customer Number practice, a practice wherein an applicant or an assignee of the entire interest of the applicant in a patent application can give power of attorney to a list of registered patent practitioners associated with a Customer Number. *See Manual of Patent Examining Procedure* (8th ed. 2001) (Rev. 1, Feb. 2003) (MPEP), Section 403, for a description of Customer Number practice. The rules are also revised to explain the requirements of a power of attorney and to limit the number of practitioners who may be given a power of attorney without using Customer Number practice. Furthermore, the patent rules are amended to discontinue the "associate" power of attorney practice, to clarify the procedures related to revocation of power of attorney, and to clarify how a registered practitioner may sign a document in a representative capacity.

Documents affecting the title to a patent or trademark property (*e.g.*, assignments, or security interests) are currently recorded in the Office's assignment database, upon submission of the document with the appropriate cover sheet and the fee required by 35 U.S.C. 41(d)(1). In addition, Government Interests are recorded, upon submission of the document, as required by Executive Order 9234 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948

Comp., p. 303). Since 1995, assignment documents have been recorded in the Office's Assignment database without stamping or otherwise marking the document that was submitted for recordation. The automated system that receives documents for recordation assigns the reel and frame number to the document and places the recordation stampings on the images that are stored in the automated system. The Office is increasing the integrity of its internal patent application record maintenance by adopting a new electronic data processing system for the storage and maintenance of all the records associated with patent applications. The new system includes the process of scanning all incoming papers to create an image file of the papers associated with patent applications. Papers that are scanned are stored, and then destroyed according to a record retention schedule. Consistent with this new practice, the Office will discontinue the practice of returning assignment documents that were mailed to the Office, and will require assignment documents to be submitted on 8½ by 11-inch paper (21.6 by 27.9 cm) ("letter size") or DIN size A4 (21.0 by 29.7 cm).

To assist applicants in identifying the application or patent to which a Notice of Recordation relates, the Notice has been revised to reflect the title of the invention and docket number stored in the Office's electronic records, if the notice of recordation is for a single property (application or patent). Any docket number included on the Assignment Cover sheet will only be used in the Office's electronic financial records for purposes of processing the recordation fee, but will not be entered into other electronic records for the patent or patent application.

#### Discussion of Specific Rules

The Office is amending sections of 1.1, 1.12, 1.31, 1.33, 1.34, 1.36, 1.53, 1.363, 3.1, 3.21, 3.24, 3.25, 3.27, 3.31, 3.34, 3.41, 3.81, and 5.1 of title 37 of the Code of Federal Regulations (CFR), and adding new § 1.32 to title 37 CFR.

**Section 1.1:** Section 1.1(a)(4)(i) is amended to add "submitted by mail" and to delete "or under § 3.81 of this chapter" to require that assignments submitted by mail contemporaneously with a request to issue a patent to an assignee be sent to Mail Stop Assignment Recordation Services instead of Mail Stop Issue Fee in order to more efficiently direct assignment documents. Section 1.1 is also amended to remove paragraph (f). The Office has determined that Mail Stop Provisional Patent Application is not useful in the

routing of correspondence within the Office.

**Section 1.12:** Section 1.12(b) is amended to replace "has not been published under 35 U.S.C. 122(b) are not available to the public" with "is open to the public pursuant to § 1.11 or for which copies or access may be supplied pursuant to § 1.14, are available to the public" in order to clarify the assignment records that are available to the public. Section 1.12(b) is further amended to provide that copies of any such assignment records and related information that are not available to the public shall be obtainable only upon written authority of the applicant or applicant's assignee, patent attorney, or patent agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in part 1.

As revised, § 1.12(b) more clearly provides, for example, for an application that is relied upon under 35 U.S.C. 120 in an application that has issued as a patent, any assignment records relating to the parent application could be considered to relate to the patent. Before the amendment to § 1.12(b), the text of the rule suggested that the assignment records for the parent application were not available to the public. This was not the intended construction, and was inconsistent with MPEP § 301.01. As revised § 1.12(b) provides that the assignment records for the parent application of a patent, or an application that has published under 35 U.S.C. 122(b), are open to public inspection.

**Section 1.31:** Section 1.31 is amended to revise the title to refer to "registered patent attorney or patent agent" and to introduce the term "power of attorney." Section 1.31 is also revised to add "United States" before "Patent and Trademark Office" in the definition of "Office" to properly reflect the current name of the Office in the rule. See 35 U.S.C. 1(a).

**Section 1.32:** New § 1.32 sets forth definitions related to power of attorney. Section 1.32 does not apply to power of attorney in an international application (§ 1.455). The terms "power of attorney," "principal," "revocation," and "Customer Number" are defined, and the requirements for a power of attorney are set forth. The term "patent practitioner" is not separately defined, but is a collective reference to a registered patent attorney or registered patent agent.

"Power of attorney" is defined in paragraph (a)(1) of § 1.32 as a written document by which a principal designates a registered patent attorney or a registered patent agent (collectively "patent practitioner") to act on his or her behalf.

"Principal" is defined in paragraph (a)(2) of § 1.32 as either the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant, and the entity who executes a power of attorney designating one or more agents to act on his or her behalf. An appointment by fewer than all of the applicants, or assignees of the entire interest of the applicants requires a petition under § 1.183 to waive the requirement of § 1.32(b)(4) that the applicant, or the assignee of the entire interest of the applicant sign the power of attorney.

The term "patentee" has not been included in this definition because use of the term "patentee" would make the rule unnecessarily complicated. Although the term "patentee" often is a reference to the assignee, the patentee could also be the inventors, or if an inventor is deceased or legally incapacitated, the inventors and the legal representative of such an inventor. An inventor who could not be reached or refused to join in the filing of a patent application would not be an applicant as set forth in § 1.41(b), but would still be a patentee, but once a patent has issued, the signature of the nonsigning inventor should still not be required on any power of attorney. Accordingly, the term "patentee" does not necessarily reference the same group of individuals as the term "applicant" and has not been used in the rules so that the applicant, not necessarily the patentee, could change the power of attorney, for example, in an application that has issued as a patent.

"Revocation" is defined in paragraph (a)(3) of § 1.32 as the cancellation by the principal of the authority previously given to a registered patent attorney or registered patent agent to act on his or her behalf.

"Customer Number" is defined in paragraph (a)(4) of § 1.32 to be a number that may be used to: (i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application or patent would be the address associated with the Customer Number; (ii) designate the fee address (§ 1.363) of a patent by a Customer Number such that the fee address for the patent would be the address associated with the Customer Number; and (iii) specify, in a power of attorney, that each of the patent practitioners associated

with a Customer Number have a power of attorney.

Section 1.32(b) sets forth the requirements for a power of attorney, other than a power of attorney in an international application (*see* § 1.455 for the power of attorney in an international application and note that Customer Number practice cannot be used in an international application). To comply with § 1.32(b), the power of attorney, in an application other than an international application, must: (1) Be in writing; (2) name one or more representatives in compliance with (c) of this section; (3) give the representative power to act on behalf of the principal; and (4) be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant. Furthermore, pursuant to § 1.32(c), a power of attorney may only name as representative: (1) One or more joint inventors (§ 1.45); (2) those registered patent practitioners associated with a Customer Number; or (3) ten or fewer registered patent attorneys or registered patent agents (*see* § 10.6 of this subchapter)(patent practitioners). Except as provided in § 1.32(c)(1) or (c)(2), the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in application or patent to which the power of attorney is directed.

New § 1.32(c)(3) sets a limit on the number of patent practitioners who can be given a power of attorney without using Customer Number practice because it is extremely burdensome for the Office to manually enter a long list of patent practitioners, particularly where the same list of patent practitioners is to be entered for a large number of applications, and to update that listing. Applicants desiring to appoint a large number of patent practitioners may continue to do so, but Customer Number practice will be required in order to have more than ten patent practitioners recognized by the Office as being of record and reflected in Office computer systems. *See* § 1.32(c)(2).

If more than ten patent practitioners have been named in a combined declaration and power of attorney (*e.g.*, from an earlier filed application (*see* § 1.63(d)(1)(iv))), then the Office of Initial Patent Examination will enter the practitioners indicated on the separate

paper filed pursuant to § 1.32(c)(3). If more than ten patent practitioners are listed on a power of attorney, and no separate paper under § 1.32(c)(3) is filed, then no patent practitioners will be made of record. If a separate paper is not provided and a patent practitioner later attempts to sign a batch update request to request that the address associated with the Customer Number be used for the correspondence address and/or the fee address for the patent applications listed on the spreadsheet (*see Notice of Elimination of Batch Update Practice to Change Power of Attorney*, 1272 Off. Gaz. Patent Office Notices 24 (July 1, 2003)), the request will be rejected because the patent practitioner is not of record. Applicant may then submit a newly executed power of attorney complying with § 1.32, or submit a copy of the previously filed power of attorney accompanied by a separate paper indicating which ten practitioners are to be made of record pursuant to § 1.32(c)(3).

Customer Number practice allows the Office to enter a single five or six digit number into the Office computer system instead of a large number of patent practitioners and is a more appropriate use of Office resources than continuing to permit applicants to give a power of attorney to an unlimited number of practitioners. *See* MPEP § 403.

Section 1.33: Section 1.33(a) is revised to reflect Customer Number practice. If applicant provides, in a single document, both a complete typed address and a Customer Number and requests that both be used for the correspondence address, the address associated with the Customer Number will be used. Section 1.33(a) is revised to include the following sentence: "If more than one correspondence address is specified in a single document, the Office will establish one as the correspondence address and will use the address associated with a Customer Number, if given, over a typed correspondence address." Applicants will often specify the correspondence address in more than one paper that is filed with an application, and the address given in the different places sometimes conflicts. Where the applicant specifically directs the Office to use a correspondence address in more than one paper, priority will be accorded to the correspondence address specified in the following order: (1) Application data sheet (ADS); (2) application transmittal; (3) oath or declaration (unless power of attorney is more current); and (4) power of attorney. Accordingly, if the ADS includes a typed correspondence

address, and the declaration gives a different address (*i.e.*, the address associated with a Customer Number) as the correspondence address, the Office will use the typed correspondence address as included on the ADS. In the experience of the Office, the ADS is the most recently created document and tends to have the most current address. After the correspondence address has been entered according to the above procedure, it will only be changed pursuant to § 1.33(a)(1).

A Customer Number merely provided in correspondence without an instruction to use the Customer Number for the correspondence address or for any other purposes, *e.g.*, a Customer Number that is adjacent the heading of the paper, is not a specific direction to use the Customer Number for any purpose.

Section 1.33(b)(1) is revised to change the reference from § 1.34(b) to new § 1.32(b).

Section 1.33(b)(2) is revised to change § 1.34(a) to § 1.34 to be consistent with the revision to § 1.34.

Section 1.33(c) revised to change the cross-reference to § 1.32(b) instead of § 1.34(b) and to change the reference to § 1.34(a) to § 1.34 to be consistent with the revision to § 1.34.

Section 1.34: Section 1.34 is revised to change the title to "Acting in a Representative Capacity." The paragraph designation for paragraph (a) and ", pursuant to § 1.31," are deleted. In addition, "the registered patent attorney or patent agent should specify his or her registration number with his or her signature" is changed to "the registered patent attorney or patent agent must specify his or her name and the registration number with his or her signature." When a registered patent attorney or patent agent acts in a representative capacity, it should be clear who is signing the paper. Because signatures are not always legible and because sometimes the wrong registration number is given, it is necessary for the registered patent attorney or agent to include his or her name so that the identity of the person who is acting in a representative capacity may be identified.

Paragraph (b) of § 1.34 is deleted. With Customer Number practice, the associate power of attorney practice set forth in § 1.34(b) is no longer necessary because once power of attorney is given to the patent practitioners associated with a Customer Number, the list of patent practitioners of record may easily be changed. Additionally, for a patent practitioner to have the most information with which to represent his client, the patent practitioner needs to

have access to the private Patent Application Information Retrieval (private PAIR) system on the Office's Internet Web site (<http://PAIR.uspto.gov>), and a patent practitioner can only have direct access to private PAIR if he or she is associated with the Customer Number, and if the Customer Number is used for the correspondence address of the application. Private PAIR provides patent practitioners with access to the Office's computer systems that track the patent file history, and, if the application is maintained in the Image File Wrapper (IFW) system, access to the images of the documents in the file history. Furthermore, private PAIR provides *pro se* applicants and patent practitioners with information about recently mailed correspondence from the Office for a particular Customer Number. Furthermore, private PAIR provides an explanation of any patent term extension or patent term adjustment calculations for the patent application. A patent practitioner who does not have access to private PAIR is disadvantaged in representing a client compared to a practitioner who has access to private PAIR. See the discussion with respect to comment 9 below.

A government entity or assignee may have multiple law firms or sets of attorneys working on their patent applications. Such an entity should consider having multiple Customer Numbers, with a separate Customer Number for each set of patent attorneys, and having at least one in-house patent practitioner listed on each listing of patent practitioners associated with a Customer Number so that the government entity or assignee has access to private PAIR for all of their patent applications.

An applicant or assignee of the entire interest of the applicant who gives a power of attorney to a limited number of patent practitioners has expressed a desire to be represented by only those patent practitioners. As § 1.34 is revised, if Customer Number practice is not used, an applicant or assignee of the entire interest of the applicant will be required to sign a new power of attorney in order for an associate practitioner to be "of record" in addition to the specifically identified principal patent practitioner. Of course, a registered patent practitioner may still act in a representative capacity pursuant to § 1.34 (by providing his or her name and a registration number with his or her signature), and the rule changes do not change this flexibility. A patent practitioner who is acting in a representative capacity pursuant to

§ 1.34 may conduct an interview with an examiner. *See* MPEP § 713.05. A patent practitioner who is acting in a representative capacity can also file amendments and other papers (§ 1.33(b)(2)). A patent practitioner who is acting in a representative capacity pursuant to § 1.34 may not, however, change the correspondence address (§ 1.33(a)(2)) (except where an executed oath or declaration has not been filed, and the patent practitioner filed the application), expressly abandon the application without filing a continuing application (§ 1.138(b)), or sign a terminal disclaimer (§ 1.321(b)(1)(iv)). A patent practitioner who is signing on behalf of the assignee of the entire interest may (*i.e.*, not signing in a representative capacity or as a patent practitioner of record), however, sign these same documents upon compliance with § 3.73(b), if the practitioner is authorized to act on behalf of the assignee.

A patent attorney or agent who has been given a power of attorney cannot change the power of attorney from the set of patent practitioners appointed by the applicant or assignee of the entire interest of the applicant to a Customer Number (or change from one Customer Number to another). To appoint a new power of attorney, the applicant or assignee of the entire interest of the applicant must be involved and must sign the power of attorney. Where a large number of patent applications of a single assignee are involved, the assignee may wish to consider giving the patent practitioners a power of attorney that is not specific to an application, similar to the General Power of Attorney used in Patent Cooperation Treaty (PCT) practice, and having one of the patent practitioners with general power of attorney take action by submitting a copy of the power of attorney and a statement in compliance with § 3.73(b). Form PTO/SB/80 is available for this purpose and is posted on the Office's Internet Web site at [www.uspto.gov](http://www.uspto.gov), under forms.

**Section 1.36:** Section 1.36 is revised to include new paragraphs (a) and (b) so that revocation of power of attorney and withdrawal as attorney or agent of record are addressed in separate paragraphs. In addition, "or authorization of agent" is deleted because the term "power of attorney" has been defined to include an authorization of an agent. The cross-reference to § 1.31 is changed to § 1.32(b).

**Section 1.36(a)** addresses revocation of a power of attorney. A registered patent attorney or patent agent is notified of any revocation with a

"Notice Regarding Change in Power of Attorney." A power of attorney to the patent practitioners associated with a Customer Number that is filed subsequent to another power of attorney will be treated as a revocation of the previously granted power of attorney. The Office can only recognize one Customer Number at a time for power of attorney purposes. When the power of attorney is to the patent practitioners associated with a Customer Number, the power of attorney is considered to be revoked when the power of attorney to the practitioners associated with the Customer Number is revoked. The revoked power of attorney may be replaced with either a new power of attorney to a new Customer Number or a power of attorney to a new list of patent practitioners. A power of attorney is not considered revoked when the list of patent practitioners associated with a Customer Number is changed (as by filing a Request for Customer Number Data Change (PTO/SB/124)). When the power of attorney is revoked, a single notice is mailed to the correspondence address in effect before the power of attorney was revoked. An associate registered patent attorney or patent agent is not separately informed of a revocation. As a result, § 1.36(a) has been revised to no longer suggest that such an associate practitioner would be separately notified of the revocation of power of attorney.

When power of attorney is given to the registered patent practitioners associated with a Customer Number, for example with PTO/SB/81, the list of patent practitioners associated with the Customer Number is changed by changing the data associated with the Customer Number (using, for example PTO/SB/124 (2 pages 124A & 124B), Request for Customer Number Data Change). No notice is given to the patent practitioners who are added or removed from the Customer Number.

**Section 1.36(b)** provides that when the power of attorney for an application is given to the practitioners associated with a Customer Number, all of the patent practitioners associated with the Customer Number will not be permitted to withdraw if an application with the power of attorney has an Office action to which a reply is due and insufficient time remains in the time period for reply for applicant to prepare a reply. *See* MPEP § 402.06.

**Section 1.53:** Section 1.53 is amended by removing paragraph (d)(9) and redesignating paragraph (d)(10) as paragraph (d)(9). The Office has determined that Mail Stop CPA is not useful in the routing of correspondence within the Office.



**Section 1.363:** Section 1.363 is amended by adding paragraph (c), which states "A fee address must be an address associated with a Customer Number." At the time of issue fee payment, applicants may designate a fee address for maintenance fee purposes (hereafter, fee address) by submitting a "Fee Address" Indication form (PTO/SB/47) as an attachment to the Fee(s) Transmittal (PTOL-85B). If no Customer Number was previously acquired from the Office for the address being designated as the fee address, a Request for Customer Number form (PTO/SB/125) should also be attached to the Fee(s) Transmittal (PTOL-85B). If a fee address is established in an allowed application or patent, the Office will send all maintenance fee correspondence (such as maintenance fee reminder notices) to the fee address; and the Office will send all other correspondence, to the correspondence address of record. *See Customer Number Required in Order to Establish a Fee Address, 1261 Off. Gaz. Pat. Office 19 (August 6, 2002).*

**Section 3.1:** Section 3.1 is revised to identify which trademark applications are covered by 37 CFR part 3, and to delete "or a transfer of its entire right, title and interest in a" so that the definition of an assignment includes a transfer of part of the right, title and interest in a registered mark or a mark for which an application to register has been filed. Section 3.1 is also revised to add "United States" before "Patent and Trademark Office" in the definition of "Office" to properly reflect the current name of the Office in the rule. See 35 U.S.C. 1(a).

**Section 3.21:** Section 3.21 is revised to change "its date of execution, name of each inventor, and title of the invention" to "the name of each inventor and the title of the invention." Section 3.21 is also revised to change "the provisional application by name of each inventor and title of the invention" to "the provisional application by the name of each inventor and the title of the invention" by adding "the" before "name" and "title."

The phrase "its date of execution" has been deleted from § 3.21 because the date of execution of a declaration is no longer required on a declaration (*see* MPEP § 602.05 and because the application could be executed on more than one date, and thus there may be no single date of execution). Accordingly, the date of execution of the application is not particularly useful in identification of the patent application and is deleted as unnecessary.

**Section 3.24:** Section 3.24 is revised to include two paragraphs, namely, paragraphs (a) and (b).

New paragraph (a) of § 3.24 addresses documents and cover sheets for electronic submissions (e.g., patent assignment documents filed via the Electronic Filing System (EFS) or the Electronic Patent Assignment System (EPAS)), and requires all documents submitted electronically to be submitted as digitized images in Tagged Image File Format (TIFF). In addition, when printed to a paper size of 8½ by 11 inches (21.6 by 27.9 cm) ("letter size") or DIN size A4 (21.0 by 29.7 cm), the document must be legible and a one-inch (2.5 cm) margin must be present on all sides.

New paragraph (b) of § 3.24 addresses documents and cover sheets for paper and facsimile submissions. Section § 3.24(b) provides that for paper submissions (e.g., documents that are mailed to the Office), the original document may no longer be submitted. Section 3.24(b) provides that "[e]ither a copy of the original document or an extract of the original document" must be submitted for recordation. Section 3.24(b) also explains why original documents should not be submitted for recording: "The Office will not return recorded documents, so original documents must not be submitted for recording." The Office is moving to uniform processing of incoming papers, with incoming papers being scanned upon receipt, electronically routed within the Office, and an appropriate reply being transmitted to applicant or his representative. With this uniform procedure, the Office will not return or retain assignment documents submitted for recordation. As a result, the Office is not permitting the submission of originals of assignment documents, and instead is requiring that a copy or an extract of an original document be submitted. The term "an extract of the original document" is being added to reflect the current practice of submitting redacted copies of assignment documents, where part of an assignment document discusses matters other than assignment of interests related to a patent.

Section 3.24 is further revised to provide, in paragraph (b), that documents (copies) submitted for recording must be on sheets of paper having a size of 8½ by 11 inches (21.6 by 27.9 cm) ("letter size") or DIN size A4 (21.0 by 29.7 cm). "Legal-size" (8½ by 14 inch or 21.64 by 33.1 cm) sheets of paper are no longer permissible. If the original assignment document is on "legal size" sheets of paper, the assignment document should be

reduced to 8½ by 11-inch or DIN size A4 paper for submission to the Office (e.g., by photocopying onto letter-size paper). Sheets of paper that are either 8½ by 11 inches (21.6 by 27.9 cm) or DIN size A4 (21.0 by 29.7 cm) are required for scanning purposes.

**Section 3.25:** Section 3.25 is amended to delete paragraph (a)(1) and renumber paragraphs (a)(2) through (4) as (a)(1) through (3), respectively. Paragraph (a)(1) is deleted to prohibit applicants from submitting the original assignment document (because applicants should retain the original of the assignment document). Paragraph (a)(1) of § 3.25, as renumbered, is further revised to insert "original" before "document" in order to clarify that only a copy of an original assignment document may be submitted for recording.

Section 3.25(c) is revised to add paragraph (1) to state that electronic submissions (e.g., ETAS for trademark assignment documents) must be attached as a digitized image in Tagged Image File Format (TIFF), to move the existing requirements for paper submissions into paragraph (2), and to specify that the document (copy) submitted for recording must have a one-inch margin when printed on 8½ by 11 inch (21.6 by 27.9 cm) or DIN size A4 (21.0 cm by 29.7 cm) paper. Legal-size paper is no longer permitted. See the discussion of this change above for patents (§ 3.24).

**Section 3.27:** Section 3.27 is revised to change "to be recorded" to "submitted by mail for recordation" because documents and cover sheets submitted for recording may be faxed or electronically submitted to the Office and need not be mailed. Only documents submitted by mail need to be addressed as set forth in the rule. Section 3.27 is also revised to delete "or with a request under § 3.81". As explained with respect to § 3.81, when an applicant requests a patent to issue to an assignee, the assignment document should be separately submitted for recordation because inclusion of the assignment document with the request to issue the patent to the assignee slows down the recordation process.

**Section 3.31:** Section 3.31(a)(7) is revised to set forth the requirements for signature of patent and trademark cover sheets filed electronically. These requirements correspond to the requirements set forth in §§ 2.33(d) and 2.193(c)(1)(iii) of this chapter for electronically transmitted trademark filings.

Trademark assignments may be submitted electronically with the Electronic Trademark Assignment

System (ETAS), which is available on the Office's Internet Web site. See <http://etas.uspto.gov/>. Patent assignments may be electronically submitted using a similar tool, the Electronic Patent Assignment System (EPAS), and may also be submitted using EFS. When submitting a copy of an assignment using ETAS or EPAS, the cover sheet is completed and signed electronically. As with electronic submission of a trademark application, a signature may be applied to an assignment cover sheet by either: (1) Placing a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks in the signature block on the electronic submission (e.g. Jane P. Doe); or (2) signing the cover sheet using some other form of electronic signature specified by the Director. See *Trademark Manual of Examining Procedure* (TMEP) § 804.05, Signature of Electronically Transmitted Applications (May 2003).

Section 3.31(c)(1) is revised to simplify the requirements for the cover sheet to only require identification of whether the document to be recorded relates to a governmental interest.

Paragraph (f) is added to § 3.31, and provides that a trademark cover sheet should include the citizenship of the parties conveying and receiving the interest, and that if the party receiving the interest is a partnership or joint venture, the cover sheet should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members. This information is required for purposes of examination of the application or registration file. Providing this information when the assignment is recorded may avoid a subsequent Office action by an examiner.

Section 3.34: Section 3.34(b) is revised to delete "the originally recorded document or" to thereby provide that it is "a copy of the document originally submitted for recording" that must be submitted. As explained above, the Office is revising the procedure for handling assignment documents and will no longer be returning the document that is submitted for recording.

Section 3.41: Section 3.41(b)(2) is revised to include electronic and facsimile submission as a means in which a statement of Government interest could be submitted for recordation without incurring a fee. Section 3.41(b)(2) is also revised to change the cross-reference to § 3.27 because § 3.27 was previously revised to delete § 3.27(b).

Section 3.81: Section 3.81(a) is revised to change "name(s)" to "name" and "assignee(s)" to "assignee" because under rules of statutory and regulatory construction, the singular includes the plural unless the context indicates otherwise. Furthermore, § 3.81(a) is amended to change "should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b)" to "must state that the document has been filed for recordation as set forth in § 3.11." When an assignment document is submitted for recording, the preferred submission is by facsimile to (703) 306-5995, or through an electronic filing system (e.g., ETAS for trademark assignment documents or EPAS or EFS for patent assignment documents), and not by mail. Accordingly, the Office has revised the rules to enable patent applicants to state that the assignment documents have been filed for recordation, rather than including the assignment documents for recordation with the request.

Paragraphs (a) and (b) of § 3.81 are revised to delete the reference to a statement under § 3.73(b). If the application has been assigned, the assignment document should be submitted for recording as set forth in § 3.11 for the patent to issue showing the name of the assignee. Although during prosecution a statement under § 3.73(b) can be relied upon to establish that an assignee is of record, pursuant to § 3.73(b)(1)(i), "the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records as a condition to permitting the assignee to take action." By the time that a patent issues, any assignment should have been submitted for recording, and reliance upon § 3.73(b) should not be necessary. Furthermore, although during prosecution of an application the Office will have an opportunity to require recordation, at issuance, prosecution has come to a close and there is no other practical opportunity for the Office to require recordation before the patent is issued.

Section 3.81(b) is revised to read "[a]fter payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request that a patent be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in

§ 1.20(a)) and the processing fee set forth in § 1.17(i) of this chapter." This modifies the practice relating to issuance of a patent to an assignee by requiring that after payment of an issue fee, a request for a certificate of correction must be filed in order to obtain issuance of the patent to an assignee. Thus, where assignment information is submitted after payment of the issue fee, the patent document will not include the assignment information, but the assignment information will be included in a Certificate of Correction. Furthermore, the practice of allowing a patent to issue to an assignee when a § 3.73(b) statement has been filed, but an assignment has not been recorded is discontinued. See MPEP § 1481. Section 3.81(c)(1) is amended to change "assignee(s)" to "assignee" and "inventor(s)" to "inventor" because the singular includes the plural unless the context indicates otherwise. See 1 U.S.C. 1.

Section 5.1: Section 5.1(a) is revised to add Mail Stop L&R to the address so that the address reads as follows: All correspondence in connection with this part, including petitions, should be addressed to: Mail Stop L&R, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. National security classified applications and other related papers may also be hand-carried to Licensing and Review, Technology Center 3600, as provided in § 5.1(c).

*Response to Comments:* The Office published a notice proposing changes to the rules of practice regarding power of attorney and assignment practice. See *Clarification of Power of Attorney Practice, and Revisions to Assignment Rules*, 68 FR 38258 (June 27, 2003), 1272 *Off. Gaz. Pat. Office Notices* 181 (July 29, 2003). The Office received nine written comments (from one intellectual property organization, seven patent practitioners, and one business). Comments in support of a change are not discussed. The other comments and the Office's response to those comments follow:

*Comment 1:* An editorial change to § 1.12(b) was recommended to change the term "such records and related information" because the use of the term was confusing.

*Response:* The suggestion has been adopted and "such records and related information" has been changed to "assignment records, digests, and indexes".

*Comment 2:* The definition of "power of attorney" in § 1.32(a) was recommended to be revised to include designating a patent attorney or patent



agent or an individual authorized to practice before the Office in patent cases. Another comment noted that the use of "agent" in § 1.32 was confusing, and recommended revision to avoid using the term "agent" to include an attorney.

*Response:* These suggestions have been adopted. The definition of power of attorney and the remainder of the rule have been revised accordingly. Instead of using "agent" the term "representative" or "patent practitioner" has been used. The term "an individual authorized to practice before the Office in patent cases" has not been included, however, because such a person is considered to have limited capacity to take action on behalf of a patent applicant (see § 10.9(a) and (b)), and is not recognized by the Office as an attorney or agent of record, and is not entered into the Office's computer systems as having a power of attorney.

*Comment 3:* The term "principal" in § 1.32(a)(2) was suggested as being too narrowly defined, and it was suggested that the term be defined broadly enough to include an appointment by fewer than all of the inventors.

*Response:* This suggestion has not been adopted, but the language has been clarified in regard to appointments by fewer than all the applicants or assignees. Where all the applicants, or the assignees of the entire interest of all the applicants, do not give power of attorney to the same patent practitioners, a petition under § 1.182 is currently required before the Office will permit the split power of attorney. See MPEP § 402.10. The term "all the inventors" is specifically not used in order to provide for the situation where an inventor is deceased or where a petition under § 1.47 has been granted (the applicant would then either be fewer than all of the inventors or the party with proprietary interest pursuant to § 1.47(b)). If the term "inventors" was used, then in any application in which a petition under § 1.47 was granted, a petition under § 1.183 would also always be required to permit the power of attorney to be signed by fewer than all of the inventors, or by an assignee who is the assignee of the entire interest of the applicant, but not the assignee of the entire interest in the application (due to the lack of an assignment from the inventor, or if deceased, the legal representative of the inventor, who did not sign the declaration). With a split power of attorney, both patent practitioners are required to sign any response to an Office action, and to participate in any interviews in the patent application, which tends to delay prosecution of the patent application.

Accordingly, applicants need to show good and sufficient reasons why more than one practitioner is necessary to represent applicants for the patent, and such an explanation will need to be provided in a petition under § 1.183 to waive the requirements of § 1.32(b)(4) for the applicant or the assignee of the entire interest of the applicant to sign the power of attorney.

*Comment 4:* One comment noted that in § 1.32(a)(3) revocation should also be defined as including the situation where the power of attorney is revoked by a new principal, and suggested that the definition be modified to address this situation. Another comment suggested that a new power of attorney act as a revocation of all prior powers of attorney.

*Response:* The suggestion to expand the definition of revocation to include revocation by a new or different principal has been adopted. In the definition of revocation (§ 1.32(a)(3)), "by the principal" has been deleted after "previously given". As to the comment that a new power of attorney act as revocation of all prior powers of attorney, this suggestion has not been adopted because automatic revocation will only occur in certain situations. When an original power of attorney is filed giving power of attorney to attorneys A, B, and C, and the same principal subsequently files another power of attorney, giving power of attorney to D without revoking all prior powers of attorney, the subsequently filed power of attorney will be treated as a revocation of the original power of attorney. Similarly, if the applicant signed the original power of attorney, and an assignee of the entire interest of the applicant later takes action and files a new power of attorney, the original power of attorney is revoked and replaced by the power of attorney filed by the assignee. In addition, if a power of attorney is given to the practitioners associated with a Customer Number, and a (second) power of attorney is later received giving power of attorney to patent practitioners associated with a different Customer Number, the second power of attorney will be processed, with the first Customer Number being replaced with the second. The power of attorney to the practitioners associated with the first Customer Number is automatically revoked in this situation. In all of these situations, the most recently filed power of attorney will control.

*Comment 5:* Several comments opposed the requirement in § 1.32(b)(2) to use Customer Number practice if more than ten patent practitioners are to be named. They argued that the

proposed rule would require an applicant to choose between naming only a law firm by using the law firm's Customer Number, or to name ten attorneys in order to name some patent practitioners in the law firm as well as others not in the law firm. The commentators encouraged the Office to consider amending the rule to allow for appointment of both practitioners and Customer Numbers, as well as more than one Customer Number. The comments argued that using different Customer Numbers for different combinations of in-house practitioners and outside firm practitioners is burdensome and risky. One comment contended that all patent practitioners associated with a Customer Number needed to be at the same address.

*Response:* Applicants and assignees currently, as a matter of practice, do have to choose between giving a power of attorney to a list of individual practitioners and a power of attorney to the practitioners associated with a Customer Number. This is because the Office's computer systems only allow either a list of individual practitioners or a Customer Number to be entered, but not both, nor more than one Customer Number. The proposal to allow for entry of multiple Customer Numbers would likely result in separate registration numbers being entered. The programming required to allow for more than one Customer Number would be very costly, and updating the list of patent practitioners would be burdensome on the Office, so it has not been adopted.

A Customer Number does not need to have only patent practitioners in a single law firm associated with it. Instead, a Customer Number can be used to list all of the patent practitioners associated with a given client and who are working together to represent the client. As a result, requiring the use of a Customer Number if more than ten attorneys are to be appointed power of attorney would not require an applicant to make the choice suggested by the comment. Furthermore, to allow any of the patent practitioners access to private PAIR, Customer Number practice must be used.

The comments have not explained why appointment of more than ten patent practitioners, particularly hundreds of patent practitioners, is necessary. When a long list of patent practitioners is submitted to the Office, this list must be constantly updated with a separate submission for each application. When a patent practitioner leaves a law firm, he must file a withdrawal for each application in which he has a power of attorney. There

could be thousands of applications in which he was given a power of attorney, even though he never personally signed a single communication in any of them. If the proper action is not taken in the application, he or she can be held responsible for the failure to take the appropriate action because he did not timely withdraw. Given the Office's extremely liberal policy of accepting correspondence from a patent practitioner who is acting in a representative capacity pursuant to § 1.34, whether someone is of record is only relevant for a patent practitioner signing a change of correspondence address, an express abandonment without filing a continuing application, or a disclaimer. The work required for the Office to constantly update the lists of patent practitioners of record in receipt, matching and processing of the relevant paper has not been shown to be justified in exchange for the value actually given to applicants.

All patent practitioners associated with a Customer Number do not need to be at the same address. A Customer Number can be used like a client number, with all the patent practitioners who represent the client being associated with a single Customer Number.

*Comment 6:* Another comment asked if more than one Customer Number could be used to designate the list of patent practitioners of record so that applicants could give power of attorney to Customer Number A (all in-house counsel), and Customer Number B (several patent practitioners who are not in-house counsel). Alternatively, it was suggested that § 1.32(b)(2) be revised to permit the naming of more than one Customer Number.

*Response:* The suggestion has not been adopted. As stated in response to comment 5, in order to implement a change to permit use of more than one Customer Number to identify either the list of patent practitioners to be made of record or the correspondence address, reprogramming of multiple Office computer systems would be required, which is an automation project that the Office does not have resources to devote to at this time. Furthermore, the Office could not reprogram the software to allow multiple Customer Numbers to be used for the list of patent practitioners without also allowing multiple Customer Numbers being used for the correspondence address because access to private PAIR is a function of the correspondence address being associated with a single Customer Number. Thus, if the Office were to allow more than one Customer Number to be given for correspondence address

purposes so that practitioners associated with each of the Customer Numbers can have access to private PAIR, then applicants would need to elect a single Customer Number for mailing purposes, and the Office would have to reprogram its system so as to be able to capture only the elected Customer Number for mailing purposes. The more Customer Numbers that the applicant has associated with a given application, the more likely that the applicant will need to change one or more of the Customer Numbers associated with the application. If only a single Customer Number is used (the Office permits up to three different Customer Numbers to be used, one for the power of attorney, one for the correspondence address and one for the fee address, but the same Customer Number can be used), then only a single Request for Customer Number Data Change can effectuate any changes necessary to the list of patent practitioners, or the address associated with a Customer Number. Given that a law firm, or a sole practitioner, can have multiple Customer Numbers without the Office being required to make any programming changes, it is more appropriate for the patent practitioners to use multiple Customer Numbers, with each Customer Number for a set of practitioners to be associated with a set of patent applications, rather than the Office to incur the cost of permitting multiple Customer Numbers to be used for the correspondence address (private PAIR access), or for the list of patent practitioners of record in an application.

*Comment 7:* Most of the comments opposed the proposal of denying entry of a power of attorney that was not in compliance with the proposed rules, and noted that there would be significant costs to applicants as a result of this policy. For example, where the power of attorney was given by the applicant in a combined declaration and power of attorney, many comments argued that a new declaration would be required to provide a proper power of attorney, and that a new declaration would be difficult to obtain because the applicant may no longer be employed by the company. Several comments emphasized the burden to applicants in changing their forms to comply with the limit of ten patent practitioners of record and requested a several-year delay in the effective date.

*Response:* After careful consideration, the Office has decided to permit applicants to supply a separate paper listing the patent practitioners who shall be made of record. Where a power of attorney is included as part of a declaration pursuant to § 1.63, and the power of attorney does not comply with

§ 1.32(b), the declaration would not be considered defective so long as the requirements of § 1.63 (or § 1.64) are met. If a separate paper indicating which ten registered patent attorneys or registered patent agents named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed is provided pursuant to § 1.32(c)(3), then the registered patent practitioners listed on the separate paper will be made of record. On the other hand, if the power of attorney does not comply with § 1.32(b) and the separate paper of § 1.32(c)(3) is not provided, then no patent practitioners will be made of record.

The Office does not encourage combined declarations and power of attorney. If such a combined format is used, however, it is recommended that the following language be inserted into the oath or declaration so that the patent practitioner will be able to take instructions from the actual client:

The undersigned hereby authorizes the U.S. attorney or agent named herein to accept and follow instructions from \_\_\_\_\_ as to any action to be taken in the United States Patent and Trademark Office regarding this application without direct communication between the U.S. attorney or agent and the undersigned. In the event of a change in the persons from whom instructions may be taken, the U.S. attorney or agent named herein will be so notified by the undersigned.

*See Responsibilities of Practitioners Representing Clients in Proceedings Before the Patent and Trademark Office, 1091 Off. Gaz. Patent Office 26 (May 25, 1988).* If the client is the company that employed the inventor, then if the company is the assignee of the entire interest of the applicant, the assignee should sign the power of attorney in the patent application, not the inventor who may no longer be employed by the assignee (company). Because an inventor who is no longer being employed by a company is unlikely to be represented by a patent practitioner who has filed a patent application on behalf of the assignee, the fact that it would be difficult to obtain the signature of the inventor on a new power of attorney is not persuasive, and a petition under § 1.183 to waive this provision of the rules is unlikely to be granted for such a reason. An inventor may be available to sign a power of attorney, but may have a divergent interest from the company. Where the company (assignee) has not chosen to intervene in the application, and the power of attorney is given by the inventor (applicant), the inventor may later revoke the original power of

attorney to the patent practitioners chosen by the assignee and appoint his/her own patent attorney and change the correspondence address in the application (or patent). Such an exercise of authority by an inventor (applicant) is appropriate so long as the assignee of the entire interest of the applicant has not appointed a power of attorney, but adds unnecessary complexity to the prosecution of the application.

Where a power of attorney lists more than ten patent practitioners and the Office enters those patent practitioners listed on a separate paper provided pursuant to § 1.32(c)(3), a patent practitioner who is not recognized as the patent attorney or patent agent of record and, as a result is not entered into the Office's computer systems, is not required to request to be withdrawn, if the practitioner ceases to represent the applicant or assignee of the applicant. If such a patent practitioner files a request to withdraw, the Office will enter the paper in the patent application file, but will not process the paper, as the practitioner cannot be withdrawn because the practitioner was not made of record and was not entered into the Office's computer records.

*Comment 8:* One comment, while questioning the wisdom of having any limit on the number of patent practitioners who may be given a power of attorney, suggested a limit of 25, and for the Office to enter in the first 25 when more than 25 are listed in a power of attorney. Alternatively, it was suggested in two comments that a fee be required for the entry of more than 10 patent practitioners. Another comment questioned the limit contending that where an application is electronically filed, the Office does not have to enter in any lists of registration numbers, because if PrintEFS were updated, the application data sheet could be scanned and optical character recognition (OCR) be used to upload the data.

*Response:* A smaller number would be preferred by some, a larger by others, but the Office has decided that ten best balances the need of applicants to appoint several practitioners without using Customer Number practice and the need of the Office to avoid unnecessary work. The suggestion to adopt a fee to accept more than a set number of patent practitioners of record is noted and may be pursued in a future rule making, but the extra burden associated with entering additional names was a significant factor for not adopting the suggestions at this time.

*Comment 9:* Many comments disapproved of the deletion of associate power of attorney practice. The comments argued that when a new

attorney takes over prosecution of a patent application from a former counsel, an associate power of attorney is useful to bridge the gap until a new power of attorney can be executed. In addition, an associate power of attorney is considered useful where a patent practitioner of record who is not in the Washington, DC, area appoints another patent practitioner within the area to assist in the prosecution for the purpose of some procedural or petition matter, but does not wish to have the practitioner made of record in all patent applications (as would happen if they used Customer Number practice, and added the practitioner to the list of practitioners associated with the Customer Number). Another comment argued that the associate power of attorney practice was desirable because of the delays in obtaining a new power of attorney, and that such delays would lead to the original attorney of record receiving correspondence for too long. Another comment suggested that the rules be amended to provide that an associate attorney's authority is not dependent upon the continued representation by the appointing principal attorney.

*Response:* Associate power of attorney practice has been eliminated because the practice is unnecessary in view of Customer Number practice. Customer Number practice, like an associate power of attorney, allows the list of patent practitioners to be changed easily to add an attorney without execution of a new power of attorney from the client, and therefore it is not necessary to be able to give an associate power of attorney if the power of attorney is to the practitioners associated with a Customer Number. Instead of using an associate power of attorney, if the power of attorney is to the patent practitioners associated with a Customer Number, a Request for Customer Number Data Change can be filed to add a practitioner that would have been given an associate power. In order to most effectively represent a patent applicant, a patent practitioner needs access to the private Patent Application Information Retrieval (private PAIR) system. Private PAIR enables the practitioner to obtain direct access the Office's electronic records for a patent application, including in many instances images of the papers in the patent application. In order to obtain access to these records, however, a Customer Number must be associated with the correspondence address of the application, and the registered practitioner must be associated with the Customer Number. The availability of the associate power

of attorney practice to add new patent practitioners would encourage practitioners to give an associate power of attorney rather than having a new power of attorney to the practitioners associated with a Customer Number signed by the applicant or assignee of the entire interest of the applicant, even though the new power of attorney to the practitioners associated with a Customer Number would enhance their ability to represent the applicant or assignee of the entire interest of the applicant because of the access to private PAIR gained by Customer Number practice.

Using a Customer Number effectively as a client number, so that both in-house patent counsel and other patent practitioners are associated with the Customer Number, may only be appropriate for clients who file many patent applications. If the set of practitioners who are representing a client on a matter is so unique that it is not efficient to establish a Customer Number specifically for this set of practitioners, then the power of attorney would be to a list of patent practitioners and the correspondence address could be given as a Customer Number so that only those patent practitioners associated with the Customer Number for the correspondence address (a subset of those with power of attorney) would have access to private PAIR.

As to the suggestion that an associate power of attorney is necessary for the attorney to conduct an interview, e.g., in the situation where a non-Washington, DC, firm appoints a Washington, DC, area patent practitioner to conduct an interview in a patent application, it is noted that the Washington, DC, patent practitioner does not need to be of record or have an associate power of attorney if the Washington, DC, practitioner has in their possession a copy of the application file. Even if the Washington, DC, practitioner does not have a copy of the application file, the practitioner may conduct an interview with "proper authority from the applicant or attorney or agent of record in the form of a paper on file in the application." See MPEP § 713.05. Should an examiner object to a practitioner who is not of record conducting the interview, the practitioner is encouraged to bring a letter signed by an attorney of record, authorizing the practitioner to conduct the interview. For example, a sample of an "Authorization to Act in a Representative Capacity" is posted on the Office's Internet Web site under "Forms" at <http://www.uspto.gov/web/forms/sb0084.pdf>. A faxed copy of the letter would be acceptable.

Similarly, a patent practitioner does not need to be of record to file a reply to an Office action. *See* § 1.34, and MPEP §§ 405 and 714.01(c). Although the practitioner who is acting in a representative capacity pursuant to § 1.34 cannot sign a change of correspondence address (§ 1.33(a)(2)), a disclaimer (§ 1.321), or a request to expressly abandon a patent application (§ 1.138) (unless also filing a continuing application), he can take all other actions necessary to continue the prosecution of the application. An associate power of attorney does not put a patent practitioner in a significantly better position to represent an applicant than they could exercise by acting in a representative capacity pursuant to § 1.34. An associate power of attorney does, however, increase the workload of the Office as the Office practice was to enter the associate patent attorneys or patent agents into the Office computer records, indicate that the practitioner is an associate attorney, and then change the listing if the primary attorney ceased to have a power of attorney, or as new associates were appointed. In order to reduce the paperwork that the Office needs to process for a patent application, the Office will no longer enter associate powers of attorney into the electronic records for patent applications so as to make the associate attorney of record.

Patent practitioners with an associate power of attorney cannot directly access private PAIR, and as a result, are less able to represent a client than one with direct access to private PAIR. Private PAIR allows access to the Office's computer records for the patent application, for example to the Patent Application Locating and Monitoring (PALM) system contents, to the patent term adjustment calculations, and, if the application is maintained in the Image File Wrapper (IFW) system, to the image filed of the documents in the file history. One particularly helpful feature of private PAIR is the "View Outgoing Correspondence," a feature that allows patent practitioners to obtain a list of applications with recently mailed correspondence, and, if the application is maintained in the IFW system, to view the documents. To have access to private PAIR for a patent application, the patent practitioner must be associated with a Customer Number that is associated with the correspondence address for the application. In addition, the patent practitioner's computer system (or his or her paralegal's computer system) must be loaded with the appropriate software. Public PAIR also allows access to much of this same

information, but is only available for applications that have either published or issued as patents. If the patent practitioner merely has an associate power of attorney, the practitioner is not associated with the Customer Number, and is not able to access Private PAIR. Without access to private PAIR, a patent practitioner may not have access to the complete patent application file and cannot fully represent the client. For example, patent term adjustment calculations are available in private PAIR, but are not mailed to applicants.

Currently, the Office records both primary attorneys of record (who may not be associated with a Customer Number) as well as associate powers of attorney in the Office's PreExam computer system, so as to have a readily available list of patent practitioners of record for a particular application. Since an associate power of attorney terminates with the termination of the power of attorney to the patent practitioner who gave the associate power of attorney, associate powers of attorney require record keeping in addition to the entry of the associate powers of attorney into attorney of record fields, because the Office must take down the associate power of attorney once the primary attorney no longer has power of attorney. The suggestion to allow an associate power of attorney to remain valid even after the power of attorney to the primary attorney has been revoked, or where the primary attorney has withdrawn, has not been adopted. If an applicant or assignee desires the associate to be an attorney of record, the applicant or assignee should sign the required power of attorney.

In the situation where a practitioner is being brought in to assist with some overflow work, no appointment of an associate power of attorney is necessary before the Office is willing to accept the paper from the practitioner. Part 1 of the rules of practice do not address engagement letters between one patent practitioner and another. As a result, if the attorney of record desires the assistance of another patent practitioner, the rules of practice do not prohibit the patent practitioner from obtaining an "Associate Power of Attorney" or "Authorization of Agent" from the patent practitioner of record for their records. Furthermore, such a document would be considered a showing under § 1.34 that a person was acting in a representative capacity pursuant to § 1.34 on behalf of the applicant.

As to the delay inherent in obtaining a new power of attorney, although the original attorney will no longer be permitted to give an associate power of

attorney, the original attorney can withdraw, or simply change the correspondence address to the new attorney's address.

*Comment 10:* One comment explained that the list of practitioners associated with a Customer Number usually only includes the partners in a firm, whereas an associate power of attorney was given to associate attorneys. The comment argued that eliminating associate power of attorney practice would hamper development of associate attorneys.

*Response:* The Office's computer system does not allow both a power of attorney to the practitioners associated with a Customer Number and either a list of patent practitioners (without use of a Customer Number) or another list of practitioners associated with a different Customer Number. Accordingly, the Office cannot enter a power of attorney to a Customer Number and an associate power of attorney. Furthermore, the relationship between being of record in a patent application (as would have occurred where the Office was able to enter an associate power of attorney), and being able to develop as a patent practitioner is not understood. A patent practitioner who is an associate at a firm could act in a representative capacity pursuant to § 1.34, under the direction of a practitioner of record. The inability to sign a change of correspondence address, has little to do with professional development.

*Comment 11:* Many comments suggested that a benefit of associate power of attorney practice is to permit someone who is not of record to conduct an interview, and that many examiners deny such an interview because the attorney is not of record, even though the Manual of Patent Examining Procedure states that such an interview is acceptable.

*Response:* Applicants desiring to have an attorney who is not of record and are concerned that the examiner may question the authority of the practitioner to conduct the interview should delegate to the practitioner the authority to conduct the interview by a separate letter, such as an "Authorization to Act in a Representative Capacity." This sample template is available on the Office's Internet Web site in the listing of forms after PTO/SB/83. A faxed copy of such a letter would be acceptable, and the practitioner could bring a copy of the letter to the interview in the event that the examiner has a question about the authority of the practitioner.

*Comment 12:* One comment noted that having applicant execute a new



power of attorney would not be unduly burdensome, but requested clarification of the effect of elimination of associate power of attorney practice upon previously filed associate powers of attorney.

*Response:* Previously filed associate powers of attorney remain valid, and will continue to be effective.

*Comment 13:* One comment noted a discomfort with the use of Customer Number practice in that if the Office transposes digits when entering the Customer Number, the correspondence goes to an entirely incorrect address.

*Response:* The Office is sensitive to the need to carefully check for the correct entry of Customer Numbers and is taking steps to ensure that the correct Customer Number is entered. For example, when the Office keys in a Customer Number, the address associated with the Customer Number is retrieved. This address is compared to the name of the firm or company that filed the patent application, and any street address included with the application papers, to check the accuracy of the Customer Number that is entered. Applicants can assist the Office in improving the accuracy of entry of the Customer Number by ensuring that the Customer Number is clear and legible (e.g., at least 12- or 14-point font and not fuzzy).

*Comment 14:* One comment stated that the proposal to require the exact name as registered with his or her signature was unreasonable, but noted that it was not clear that the exact name as registered was in fact being proposed to be required.

*Response:* The Office did intend to propose to require the exact name as registered, as this change was also included in the rule changes proposed in a recent notice of proposed rule making. See *Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 68 FR 53816 (Sep. 12, 2003), 1275 *Off. Gaz. Pat. Office Notices* (Oct. 7, 2003) (proposed rule). On reflection, the Office agrees that it is not necessary to obtain the exact name as registered to confirm the identity of the person signing the correspondence, but will instead require the typed name of the person signing the correspondence. Signatures are not always legible, and digits on registration numbers are sometimes transposed or inadvertently omitted. Accordingly, having a typed name is considered necessary.

*Comment 15:* As to § 1.36, one comment stated that the revocation of the power of attorney should be available to fewer than all of the

inventors, or fewer than the assignee of the entire interest of the applicant.

*Response:* The suggestion has not been adopted. The current practice is to permit revocation by fewer than all of the applicants only if a petition under § 1.182 is filed, explaining why a split power of attorney is necessary. See MPEP § 402.10. Having more than one attorney or an attorney and an applicant required to sign all correspondence in an application often leads to the application becoming abandoned due to the difficulty in obtaining the necessary signatures. As a result, the rules have not been amended to provide for fewer than all of the applicants to be able to revoke the power of attorney without a showing of sufficient cause.

*Comment 16:* One comment suggested that .jpg files be added to the list of formats accepted for electronic submission of assignment documents pursuant to § 3.24 and § 3.25, arguing that this format is accepted in Trademarks.

*Response:* At this time it is not feasible for the Office to expand the formats that will be accepted for electronic submission of assignment documents. The format .jpg is acceptable for Trademark documents filed through Trademark Electronic Application System (TEAS), but not assignments of Trademarks filed through ETAS.

*Comment 17:* Two comments noted the change in practice proposed in § 3.34 would be more acceptable to applicants if the Notice of Recordation were modified to also include an Attorney Docket Number, as well as the title of the invention according to the application on filing. Alternatively, one comment suggested use of the Express Mail number as an identifier on the Notice of Recordation.

*Response:* The proposal to use the Express Mail number as an identifier is not adopted. The Office can process faxed or electronically filed assignment documents much quicker than those received by mail, and allowing use of an Express Mail number would promote a practice of mailing at a time when the Office is seeking to discourage mailing and encourage electronic submissions. The Office has, however, adopted the suggestion to include the title of the invention, but notes that the title that will be printed on the Notice of Recordation is the title reflected in the Office's computer records, and will not be rekeyed from the assignment. As to the attorney docket number, the suggestion has also been adopted, if the assignment is for a single property. The notice of recordation cannot reflect

docket numbers if the assignment is for more than one patent or trademark.

*Comment 18:* Another comment stated that sometimes the wrong patent assignment document is attached to the Notice of Recordation, and having a copy of the document has been useful in the past to enable the mix-up to be addressed.

*Response:* The Office has made patent and trademark assignment records available over the Internet. Although the copy of a patent assignment document cannot be displayed using <http://assignments.uspto.gov/assignments/q?db=pat>, the assignment records on the Internet provide a mechanism to check if the patent assignment was recorded correctly.

*Administrative Procedure Act:* This final rule changes the rules of practice to Office procedures involving power of attorney practice and recording of assignment documents. The changes addressed in this final rule are limited to the format for and the manner of submitting, establishing and changing the power of attorney, for submitting documents to be recorded in the assignment records, and the availability of assignment records to the public. Therefore, these changes involve rules of agency practice and procedure under 5 U.S.C. 553(b)(A). See *Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (DC Cir. 2001). Therefore, prior notice and opportunity for public comment were not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). Nevertheless, the Office did provide an opportunity for public comment on the changes in the notice of proposed rule making because the Office desires the benefit of public comment on the proposed changes.

*Regulatory Flexibility Act:* As prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553 (or any other law), a regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required. See 5 U.S.C. 603. The changes in this final rule impose no additional fees on patent applicants.

*Executive Order 13132:* This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

*Executive Order 12866:* This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

*Paperwork Reduction Act:* This final rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork

Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this final rule have been reviewed and previously approved by OMB under OMB control numbers 0651-0027, 0651-0032, 0651-0034, and 0651-0035. The changes in this final rule do not affect the information requirements associated with these information collections. Therefore, the Office is not submitting these information collection packages to OMB for review and approval.

The title, description and respondent description of each of the information collections are shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impacts of the changes in this proposed rule are to: (1) Provide for power of attorney to a Customer Number and to limit the number of attorneys who may be given a power of attorney without using a Customer Number; (2) eliminate associate power of attorney practice; (3) require attorneys acting in a representative capacity to specify their name and registration number; (4) allow access to assignment records except those relating to any pending or abandoned patent application which is preserved in confidence under § 1.14; (5) provide that assignment documents submitted for recording must be on certain sizes of paper; (6) specifically state that the assignment documents that are submitted for recording will not be returned; (7) for assignments that are submitted electronically, provide for an electronic signature; (8) require the citizenship of the parties conveying and receiving the interest on a trademark assignment cover sheet; (9) provide that a request to issue a patent to an assignee filed after issue fee payment must be accompanied by a request for a certificate of correction; and (10) change the address that would be used for mailing certain patent applications.

OMB Number: 0651-0027.

Title: Recording Assignments.

Form Numbers: PTO-1594 and PTO-1595.

Type of Review: Approved through June of 2005.

Affected Public: Individuals or households, business or other for-profit institutions, not-for-profit institutions, farms, Federal Government, and State, local, or tribal governments.

Estimated Number of Respondents: 240,345.

Estimated Time Per Response: 30 minutes.

Estimated Total Annual Burden Hours: 120,173 hours.

Needs and Uses: The Office records over 200,000 assignments or documents related to ownership of patent and trademark cases each year. The Office requires a cover sheet to expedite the processing of these documents and to ensure that they are properly recorded.

OMB Number: 0651-0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01-07, PTO/SB/13PCT, PTO/SB/16-19, PTO/SB/29 and 29A, PTO/SB/101-110.

Type of Review: Approved through July of 2006.

Affected Public: Individuals or households, business or other for-profit institutions, not-for-profit institutions, farms, Federal Government, and State, local, or tribal governments.

Estimated Number of Respondents: 454,287.

Estimated Time Per Response: 22 minutes to 10 hours and 45 minutes.

Estimated Total Annual Burden

Hours: 4,171,568 hours.

Needs and Uses: The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, Provisional Application Cover Sheet, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the USPTO in processing and examination of the application.

OMB Number: 0651-0034.

Title: Secrecy and License to Export.

Form Numbers: None.

Type of Review: Approved through April of 2004.

Affected Public: Individuals or households, business or other for-profit institutions, not-for-profit institutions, farms, Federal Government, and State, local, or tribal governments.

Number of Respondents: 1,669.

Estimated Time Per Response:

Between 30 minutes and 4 hours.

Estimated Total Annual Burden

Hours: 1,310 hours.

Needs and Uses: When disclosure of an invention may be detrimental to national security, the Director of the USPTO must issue a secrecy order and withhold the publication of the application or grant of a patent for such period as the national interest requires. The USPTO is also required to grant

foreign filing licenses in certain circumstances to applicants filing patent applications in foreign countries. This collection is used by the public to petition the USPTO to allow disclosure, modification, or rescission of a secrecy order, or to obtain a general or group permit. Applicants may also petition the USPTO for a foreign filing license, a retroactive license, or to change the scope of a license.

OMB Number: 0651-0035.

Title: Representative and Address Provisions.

Form Numbers: PTO/SB/80/81/82/83/122/123/124A/124B/125A/125B.

Type of Review: Approved through November of 2005.

Affected Public: Individuals or households, business or other for-profit, not for-profit institutions and Federal Government.

Estimated Number of Respondents: 355,005.

Estimated Time Per Response: 3 minutes (0.05 hours) to 1 hour 30 minutes (1.5 hours).

Estimated Total Annual Burden Hours: 30,088 hours.

Needs and Uses: Under 35 U.S.C. 2 and 37 CFR 1.31-1.36 and 1.363, this information is used to submit a request to grant or revoke power of attorney in an application or patent, to withdraw as patent attorney or patent agent of record, or to designate or change the correspondence address for one or more applications or patents, and to request or change information associated with a customer number.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503, (Attn: USPTO Desk Officer).

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

## List of Subjects

### 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.



**37 CFR Part 3**

Administrative practice and procedure, inventions and patents, Reporting and record keeping requirements.

**37 CFR Part 5**

Classified information, foreign relations, inventions and patents.

■ For the reasons set forth in the preamble, 37 CFR parts 1, 3 and 5 are amended as follows:

**PART 1—RULES OF PRACTICE IN PATENT CASES**

■ 1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

■ 2. Amend § 1.1 by revising paragraph (a)(4)(i) to read as follows, and by removing and reserving paragraph (f).

**§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.**

(a) \* \* \*

(4) *Office of Public Records correspondence.* (i) Assignments. All patent-related documents submitted by mail to be recorded by Assignment Services Division, except for documents filed together with a new application, should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. See § 3.27.

\* \* \* \* \*

(f) [Reserved]

■ 3. Revise § 1.12(b) to read as follows:

**§ 1.12 Assignment records open to public inspection.**

\* \* \* \* \*

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application, which is open to the public pursuant to § 1.11 or for which copies or access may be supplied pursuant to § 1.14, are available to the public. Copies of any assignment records, digests, and indexes that are not available to the public shall be obtainable only upon written authority of the applicant or applicant's assignee or patent attorney or patent agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in this part.

\* \* \* \* \*

■ 4. Revise § 1.31 to read as follows:

**§ 1.31 Applicants may be represented by a registered patent attorney or patent agent.**

An applicant for patent may file and prosecute his or her own case, or he or she may give a power of attorney so as to be represented by a registered patent attorney or registered patent agent. See § 10.6 of this subchapter. The United States Patent and Trademark Office cannot aid in the selection of a registered patent attorney or patent agent.

■ 5. Add new § 1.32 to read as follows:

**§ 1.32 Power of attorney.**

(a) Definitions.

(1) *Power of attorney* means a written document by which a principal designates a registered patent attorney or a registered patent agent to act on his or her behalf.

(2) *Principal* means either an applicant for patent (§ 1.41(b)) or an assignee of entire interest of the applicant. The principal executes a power of attorney designating one or more registered patent attorneys or registered patent agents to act on his or her behalf.

(3) *Revocation* means the cancellation by the principal of the authority previously given to a registered patent attorney or registered patent agent to act on his or her behalf.

(4) *Customer Number* means a number that may be used to:

(i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application or patent would be the address associated with the Customer Number;

(ii) Designate the fee address (§ 1.363) of a patent such that the fee address for the patent would be the address associated with the Customer Number; and

(iii) Submit a list of practitioners such that those registered patent practitioners associated with the Customer Number would have power of attorney.

(b) A power of attorney must:

(1) Be in writing;

(2) Name one or more representatives in compliance with (c) of this section;

(3) Give the representative power to act on behalf of the principal; and

(4) Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.

(c) A power of attorney may only name as representative:

(1) One or more joint inventors (§ 1.45);

(2) Those registered patent practitioners associated with a Customer Number;

(3) Ten or fewer registered patent attorneys or registered patent agents (see

§ 10.6 of this subchapter) (patent practitioners). Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in application or patent to which the power of attorney is directed.

■ 6. Amend § 1.33 by revising paragraphs (a) introductory text, (b) introductory text, (b)(1), (b)(2) and (c) to read as follows:

**§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.**

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a registered patent attorney or patent agent, or with more than one registered patent attorney or patent agent except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will establish one as the correspondence address and will use the address associated with a Customer Number, if given, over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

\* \* \* \* \*

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);

(2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;

\* \* \* \* \*

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the patent attorney or patent agent of record (*see* § 1.32(b)) in the patent file at the address listed on the register of patent attorneys and patent agents maintained pursuant to § 10.5 and § 10.11 or, if no patent attorney or patent agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by a patent attorney or patent agent of record in the patent file, or by a registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's patent attorney or patent agent, or with more than one patent attorney or patent agent, will not be undertaken. If more than one patent attorney or patent agent is of record and a correspondence address has not been specified, correspondence will be held with the last patent attorney or patent agent made of record.

\* \* \* \* \*

■ 7. Revise § 1.34 to read as follows:

**§ 1.34 Acting in a representative capacity.**

When a registered patent attorney or patent agent acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the registered patent attorney or patent agent must specify his or her registration number and name with his or her signature. Further proof of authority to act in a representative capacity may be required.

■ 8. Revise § 1.36 to read as follows:

**§ 1.36 Revocation of power of attorney; withdrawal of patent attorney or patent agent.**

(a) A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(h). A registered patent attorney or patent agent will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. *See* § 1.613(d) for withdrawal in an interference.

**§ 1.53 [Amended]**

■ 9. Amend § 1.53 by removing paragraph (d)(9) and redesignating paragraph (d)(10) as paragraph (d)(9).

■ 10. Revise § 1.363 by adding paragraph (c) as follows:

**§ 1.363 Fee address for maintenance fee purposes.**

\* \* \* \* \*

(c) A fee address must be an address associated with a Customer Number.

**PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE**

■ 11. The authority citation for 37 CFR part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

■ 12. Revise § 3.1 to read as follows:

**§ 3.1 Definitions.**

For purposes of this part, the following definitions shall apply:

*Application* means a national application for patent, an international patent application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051 or 15 U.S.C. 1126, unless otherwise indicated.

*Assignment* means a transfer by a party of all or part of its right, title and interest in a patent, patent application, registered mark or a mark for which an application to register has been filed.

*Document* means a document which a party requests to be recorded in the Office pursuant to § 3.11 and which affects some interest in an application, patent, or registration.

*Office* means the United States Patent and Trademark Office.

*Recorded document* means a document which has been recorded in the Office pursuant to § 3.11.

*Registration* means a trademark registration issued by the Office.

■ 13. Revise § 3.21 to read as follows:

**§ 3.21 Identification of patents and patent applications.**

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, *e.g.*, 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number (*e.g.*, PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the

patent application by the name of each inventor and the title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and the title of the invention so that there can be no mistake as to the provisional application intended.

■ 14. Revise § 3.24 to read as follows:

**§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.**

(a) *For electronic submissions:* Either a copy of the original document or an extract of the original document may be submitted for recording. All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), the document must be legible and a 2.5 cm (one-inch) margin must be present on all sides.

(b) *For paper or facsimile submissions:* Either a copy of the original document or an extract of the original document must be submitted for recording. Only one side of each page may be used. The paper size must be either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), and in either case, a 2.5 cm (one-inch) margin must be present on all sides. For paper submissions, the paper used should be flexible, strong white, non-shiny, and durable. The Office will not return recorded documents, so original documents must not be submitted for recording.

■ 15. Revise § 3.25 to read as follows:

**§ 3.25 Recording requirements for trademark applications and registrations.**

(a) *Documents affecting title.* To record documents affecting title to a trademark application or registration, a legible cover sheet (see § 3.31) and one of the following must be submitted:

- (1) A copy of the original document;
- (2) A copy of an extract from the document evidencing the effect on title; or

(3) A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

(b) *Name changes.* Only a legible cover sheet is required (See § 3.31).

(c) *All documents.* (1) *For electronic submissions:* All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another

form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), a 2.5 cm (one-inch) margin must be present on all sides.

(2) *For paper or facsimile submissions:* All documents should be submitted on white and non-shiny paper that is either 8½ by 11 inches (21.6 by 27.9 cm) or DIN size A4 (21.0 by 29.7 cm) with a one-inch (2.5 cm) margin on all sides in either case. Only one side of each page may be used. The Office will not return recorded documents, so original documents should not be submitted for recording.

■ 16. Revise § 3.27 to read as follows:

**§ 3.27 Mailing address for submitting documents to be recorded.**

Documents and cover sheets submitted by mail for recordation should be addressed to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, unless they are filed together with new applications.

■ 17. Amend § 3.31 by revising paragraphs (a)(7) and (c)(1) and adding a paragraph (f) to read as follows:

**§ 3.31 Cover sheet content.**

(a) \* \* \*

(7) The signature of the party submitting the document. For an assignment document or name change filed electronically, the person who signs the cover sheet must either:

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks submission (e.g./Thomas O'Malley III/) in the signature block on the electronic submission; or

(ii) Sign the cover sheet using some other form of electronic signature specified by the Director.

\* \* \* \* \*

(c) \* \* \*

(1) Indicate that the document relates to a Government interest; and

\* \* \* \* \*

(f) Each trademark cover sheet should include the citizenship of the party conveying the interest and the citizenship of the party receiving the interest. In addition, if the party receiving the interest is a partnership or joint venture, the cover sheet should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture.

■ 18. Revise § 3.34 to read as follows:

**§ 3.34 Correction of cover sheet errors.**

(a) An error in a cover sheet recorded pursuant to § 3.11 will be corrected only if:

(1) The error is apparent when the cover sheet is compared with the recorded document to which it pertains, and

(2) A corrected cover sheet is filed for recordation.

(b) The corrected cover sheet must be accompanied by a copy of the document originally submitted for recording and by the recording fee as set forth in § 3.41.

■ 19. Revise § 3.41(b)(2) to read as follows:

**§ 3.41 Recording fees.**

\* \* \* \* \*

(b) \* \* \*

(2) The document and cover sheet are either: Faxed or electronically submitted as prescribed by the Director, or mailed to the Office in compliance with § 3.27.

■ 20. Revise § 3.81 to read as follows:

**§ 3.81 Issue of patent to assignee.**

(a) *With payment of the issue fee:* An application may issue in the name of the assignee consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request must state that the document has been filed for recordation as set forth in § 3.11.

(b) *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17(i) of this chapter.

(c) *Partial assignees.* (1) If one or more assignee, together with one or more inventor, holds the entire right, title, and interest in the application, the patent may issue in the names of the assignee and the inventor.

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

# **PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES**

## ■ 21. The authority citation for 37 CFR part 5 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

## ■ 22. Revise 5.1(a) to read as follows:

### **§ 5.1 Applications and correspondence involving national security.**

(a) All correspondence in connection with this part, including petitions, should be addressed to: Mail Stop L&R, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313–1450.

\* \* \* \* \*

Dated: May 18, 2004.

Jon W. Dudas,

*Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office.*

[FR Doc. 04–11761 Filed 5–25–04; 8:45 am]

BILLING CODE 3510–16–P

## **ENVIRONMENTAL PROTECTION AGENCY**

### **40 CFR Part 52**

[CA 040–0448a; FRL–7662–2]

**Revisions to the California State Implementation Plan, El Dorado County Air Pollution Control District, Feather River Air Quality Management District, Kern County Air Pollution Control District, Sacramento Metropolitan Air Quality Management District, San Bernardino County Air Pollution Control District, Santa Barbara County Air Pollution Control District, and Yolo-Solano Air Pollution Control District**

AGENCY: Environmental Protection Agency (EPA).

**ACTION:** Direct final rule.

**SUMMARY:** EPA is taking direct final action to approve revisions to the El Dorado County Air Pollution Control District (EDCAPCD), Feather River Air Quality Management District (FRAQMD), Kern County Air Pollution Control District (KCAPCD), Sacramento Metropolitan Air Quality Management District (SMAQMD), San Bernardino County Air Pollution Control District (now Mojave Desert Air Quality Management District) (MDAQMD), Santa Barbara County Air Pollution Control District (SBCAPCD), and Yolo-Solano Air Pollution Control District (YSAPCD) portions of the California State Implementation Plan (SIP). Under authority of the Clean Air Act as amended in 1990 (CAA or the Act), we are approving local rules that address emission statements.

**DATES:** This rule is effective on July 26, 2004, without further notice, unless EPA receives adverse comments by June 25, 2004. If we receive such comments, we will publish a timely withdrawal in the Federal Register to notify the public that this direct final rule will not take effect.

**ADDRESSES:** Send comments to Andy Steckel, Rulemaking Office Chief (AIR–4), U.S. Environmental Protection Agency, Region IX, 75 Hawthorne Street, San Francisco, CA 94105–3901 or e-mail to [steckel.andrew@epa.gov](mailto:steckel.andrew@epa.gov), or submit comments at <http://www.regulations.gov>.

You can inspect copies of the submitted SIP revisions, EPA's technical support documents (TSDs), and public comments at our Region IX office during normal business hours by appointment. You may also see copies of the submitted SIP revisions by appointment at the following locations:

Air and Radiation Docket and Information Center, U.S. Environmental Protection Agency, Room B–102, 1301 Constitution Avenue, NW., (Mail Code 6102T), Washington, DC 20460.

California Air Resources Board, Stationary Source Division, Rule Evaluation Section, 1001 "I" Street, Sacramento, CA 95814.

El Dorado County Air Pollution Control District, 2850 Fairlane Court, Building C, Placerville, CA 95667–4100.

Feather River Air Quality Management District, 938–14th Street, Marysville, CA 95901–4149.

Kern County Air Pollution Control District, 2700 "M" Street, Suite 302, Bakersfield, CA 93301–2370.

Mojave Desert Air Quality Management District, 14306 Park Avenue, Victorville, CA 92392–2310.

Sacramento Metropolitan Air Quality Management District, 777–12th Street, Third Floor, Sacramento, CA 95814–1908.

Santa Barbara County Air Pollution Control District, 26 Castilian Drive, Suite B–23, Goleta, CA 93117–3027.

Yolo-Solano Air Quality Management District, 1947 Galileo Court, Suite 103, Davis, CA 95616–4882.

Copies of the rules may also be available via the Internet at the following site: <http://www.arb.ca.gov/drdb/drdb.txt>. Please be advised that this is not an EPA Web site and may not contain the same version of the rules that were submitted to EPA.

**FOR FURTHER INFORMATION CONTACT:** Julie A. Rose, EPA Region IX, (415) 947–4126, [rose.julie@epa.gov](mailto:rose.julie@epa.gov).

**SUPPLEMENTARY INFORMATION:** Throughout this document, "we," "us" and "our" refer to EPA.

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### **I. The State's Submittal**

#### **A. What Rules Did the State Submit?**

Table 1 lists the rules we are approving with the dates that they were adopted by the local air agencies and submitted by the California Air Resources Board (CARB).

**TABLE 1.—SUBMITTED RULES**

Local agency	Rule #	Rule title	Adopted	Submitted
EDCAPCD .....	1000 .....	Emission Statement .....	09/21/92	11/12/92
FRAQMD .....	4.8 .....	Further Information .....	09/14/92	11/12/92
KCAPCD .....	108.2 .....	Emission Statement Requirements .....	07/13/92	11/12/92
MDAQMD .....	107 .....	Certification and Emission Statements .....	09/17/92	11/12/92
SMAQMD .....	105 .....	Emission Statements .....	04/20/93	11/18/93
SBCAPCD .....	212 .....	Emission Statements .....	10/20/92	11/12/92